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Steven Tischer

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EXAMINER

LEVINE, ADAM L

ART UNIT

PAPER NUMBER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/736,470	<b>Applicant(s)</b> TISCHER, STEVEN	
	<b>Examiner</b> ADAM LEVINE	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8-15 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-15, and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

Applicant's amendments and remarks filed May 8, 2008, are responsive to the office action mailed February 11, 2007. Claims 1-5, 8-15, and 19-21 were previously pending. Claims 1, 5, 8, 10, 14, and 21 are amended and no claims are cancelled, therefore claims 1-5, 8-15, and 19-21 are currently pending and considered in this office action.

### ***Response to Amendment***

#### Pertaining to rejection under 35 USC §112 in the previous office action

Claims 1-5, 8-15, and 19-21 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification describes a third data set generated based on similar first and second attributes from first and second data sets. The master data set is a compilation of the common attributes gathered from accumulated third data sets. The applicant has attempted to increase the refinement and complexity of the invention exponentially by including a third data set in the claims that functions similarly to the first and second data sets described in the specification and by creating a fourth data set that reflects the function previously performed by the third data set. This is new matter. Renaming the fourth

data set as the "master data set" does not change the fact that it's essential purpose has been changed and that the now claimed invention has not been disclosed in the specification.

### ***Response to Arguments***

#### **Pertaining to rejection under 35 USC §112 in the previous office action**

Applicant's arguments filed May 8, 2008, have been fully considered but they are not persuasive. Claims 1-5, 8-15, and 19-21 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification describes a third data set generated based on similar first and second attributes from first and second data sets. It does not describe a fourth data set. The claims now are directed to a third data set that is not derived from similar first and second attributes from first and second data sets, but is derived in a manner similar to that originally practiced by only the first and second data sets. The claims are also now directed to a master data set that is generated in a manner similar to that only disclosed in the specification as being practiced by the third data set. The essential function and purpose of the master set disclosed in the specification is not claimed.

Applicant argues that support for these features is found in the specification at paragraphs 0026-0027. This is incorrect. Applicant focuses arguments on a largely

semantic concept dealing with the actual number of data sets in arguing that the specification has actually disclosed three data sets and a master (fourth) data set. Unfortunately, the applicant in making this argument completely disregards the essential purposes and functions of the respective data sets. It is true that the first and second data sets could represent any number of actual data sets (see figure 2). This is also the case in the prior art. The difficulty is that the applicant is now attempting to change the essential purposes and functions of the disclosed third and master data sets. It is here noted that, with the present amendments, all of the data sets named in the specification are now present in the claims. This has led to the new 112 rejection for failure to claim the invention described in the specification because the third and master data sets are claimed as performing different functions than those disclosed.

As now claimed, the master data set has taken the place of what was the third data set in the specification, and the third data set is merely a redundancy of the data sets previously claimed as the first and second sets.

It is here noted perhaps tangentially that once multiple data sets with the same function are disclosed, increasing or decreasing the actual number would be obvious variants. Applicant originally changed the purpose of the third data set and inserted the fourth in an attempt to overcome the prior art but this attempt was ineffective. It would have been ineffective because of this obviousness if not for the fact that the prior art reference explicitly discloses a virtually limitless number of potential data sets.

Pertaining to rejection under 35 USC §102(b) in the previous office action

Applicant's arguments filed May 8, 2008, have been fully considered but they are not persuasive. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections. Applicant's remarks do not address the relevant portions of the prior art reference as set forth below.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. **Claims 1-5,8-15, and 19-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification describes a third data set generated based on similar first and second attributes from first and second data sets. The master data set is a compilation

of the common attributes gathered from accumulated third data sets. The applicant has attempted to increase the refinement and complexity of the invention exponentially by including a third data set in the claims that functions similarly to the first and second data sets described in the specification and by creating a master data set that reflects the function previously performed by the third data set. This is new matter. The essential purpose of both the third and master data sets have been changed and the now claimed invention has not been disclosed in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claims 1-5, 8-15, and 19-21 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.** Evidence that claims 1-5, 8-15, and 19-21 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the reply filed May 8, 2008, and in the specification. In that paper, applicant has stated that the third and master data sets are described in specification paragraphs 0026 and 0027, and this statement indicates that the invention is different from what is defined in the claim(s) because third and master data sets described in the specification are different in both function and purpose from the third and master data sets described in the specification.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**2. Claims 1-5, 8-15, and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Herz (Paper # 060324; US Patent No. 6,029,195).**

Herz teaches a system for comparing attributes of multiple data sets to determine similarities and then create new data sets based on the similarities. Herz further teaches:

- determining when the entity selects a first service or product: generating a first data set having a first attribute associated with the first service or product (see at least abstract, fig.10); wherein the first data set is generated by a digital video recording device and includes a unique identifier associated with an entity, a date, a time and a title of a program or movie selected by the entity for recording on the digital video recording device (see at least abstract, column 32 line 65-column 33 line 59, column 43 line 53-column 44 line 49, column 39 line 57 – column 40 line 33. Please note: passages show that electronic media includes video and that video recording devices are among the potential devices that generate profile data. Please note: The particular information included in the data set is descriptive material and is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381 , 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106); first

device configured to determine whether the entity purchases, submits an order for the first service or product (see at least column 5 lines 36-45, column 18 line 40-column 19 line 7, column 68 lines 5-10, column 77 lines 17-47); a first network device generates the first data set (see at least abstract, fig.1,2); a first device configured to determine when the entity selects a first service or product and generating a first data set having a first attribute associated with the first service or product (see at least abstract, fig.1,2,10,12); first device comprises one of a computer, a cellular phone, or a digital video recording device (see at least fig.1,2);

- determining when the entity selects a second service or product: generating a second data set having a second attribute associated with the second service or product (see at least abstract); wherein the second data set is generated by a personal computer, the second data set including a unique identifier associated with an entity, a data, a time, and a web address accessed by the personal computer (see at least abstract, figs.1,2; column 7 lines 19-51, column 12 line 61 – column 13 line 41, column 32 line 65-column 33 line 59, column 67 line 30 – column 68 line 21, column 72 line 65 – column 73 line 42); a second device configured to determine when the entity selects a second service or product and generating a second data set having a second attribute associated with the second service or product (see at least abstract, fig.1,2,10);
- determining when the entity selects a third service or product: generating a third data set having a third attribute associated with the third service or product (see

at least abstract); wherein the third data set is generated by a store computer, the third data set including a unique identifier associated with an entity, a date, a time, and a title of an item purchased by the entity (see at least abstract, figs.1,2; column 7 lines 19-51, column 12 line 61 – column 13 line 41, column 32 line 65- column 33 line 59, column 67 line 30 – column 68 line 21, column 72 line 65 – column 73 line 42);

- generating a master data set based on the first, second, and third attributes: when a portion of data associated with the first attribute matches a portion of data associated with the second attribute and third attribute (see at least abstract, column 5 lines 6-20, column 26 lines 2-21); a fourth network device generates the master data set (see at least abstract, figs.1,2); a fourth device configured to generate a master data set based on the first, second, and third attributes when a portion of data associated with the first attribute is substantially similar to a portion of data associated with the second and third attributes (see at least abstract, figs.1,2,10; column 5 lines 6-20, column 26 lines 2-21); fourth device is operably associated with a grid computer network (see at least abstract, figs.1,2); fourth device comprises a computer server communicating with the first, second, and third devices (see at least figs.1,2);
- the master data set including a plurality of potential interest elements: based on a number of matches between the first, second, and third attributes (see at least abstract, figs.10-15, column 2 line 39 – column 3 line 10);

- ranking the potential interest elements in the master data set: based on the number of matches: between the first, second and third attributes (see at least abstract, figs. 11-12, 16; column 4 lines 4-27);
- the data associated with the first attribute comprises textual data: and the data associated with the second attribute comprises textual data and the portion of the data associated with the third attribute comprises textual data (see at least abstract, column 5 lines 6-20, column 9 lines 19-30, column 77 lines 17-47); generating the master data set based on the first, second, and third attributes includes determining whether at least a portion of the textual data of the first attribute is identical to at least a portion of the textual data of the second attribute and third attribute and forming the master data set having a fourth attribute containing at least a portion of textual data from one of the first, second, and third attributes (see at least abstract, column 5 lines 6-20, column 77 lines 17-47);
- entity comprises one of a person or a group of people: (see at least abstract, column 9 lines 31-42. Please note: the identity of the entity has no functional role in the method and a person or group of people are themselves not patentable subject matter.).
- A storage medium encoded with machine-readable computer program code for generating data sets associated with an entity: (see at least column 9 lines 19-30).
- generating a plurality of historic data sets by monitoring activities of a legal entity: (see at least fig.10, column 77 lines 17-47); identifying a plurality of attributes

contained in the plurality of historic data sets (see at least figs.5,10, column 77 lines 17-47); determining a plurality of values wherein each value is associated with one attribute of the plurality of attributes and corresponds to a number of historic data sets of the plurality of historic data sets containing the one attribute (see at least fig.12); determining a plurality of dynamic data sets containing the attributes wherein the plurality of dynamic data sets are ranked based on the plurality of values (see at least abstract, fig.12, column 18 line 40-column 19 line 7, column 19 line 29-column 20 line 22, column 77 lines 48-67); iteratively generating the plurality of historic data sets by monitoring activities of the legal entity (see at least abstract, figs.5,10; column 20 line 47-column 21 line 4).

*Pertaining to method claims 1-5 and 8-9*

Rejection of claims 1-5 and 8-9 is based on the same rationale as noted above.

*Pertaining to encoded storage medium claim 21*

Rejection of claim 21 is based on the same rationale as noted above.

Examiner cites particular columns and line numbers in the reference as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within claims, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the reference in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM LEVINE whose telephone number is (571)272-8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Smith/  
Supervisory Patent Examiner, Art  
Unit 3625

Adam Levine  
Patent Examiner  
August 7, 2008